

REMARKS

Upon entry of the present amendment, claims 1-11 and 15-20 will be pending in the application.

No claims have been canceled or added. Claims 1 and 18 have been amended to correct minor typographical errors. New claim 20 sets forth the subject matter of objected claim 19 in independent form with all of the limitations of the base claim 1 and any intervening claims. Allowance of new claim 20 is respectfully requested.

Amendments to the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments.

Applicants thank the PTO for the withdrawal of the 35 U.S.C. 103 rejections set forth in Section 4 of the Office Action of 1/5/09.

Applicants also thank the PTO for allowance of claim 18 and the conditional allowance of claim 19. However the Applicants believe that claims 1-11, 15-17, and 19 are independently allowable for the reasons set forth below. Therefore, reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. **Rejection of claims 1-11 and 15-17 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.**

The basis of rejection is understood to be as follows:

With respect to claims 1 and 18, the property of "shows not settling after six months" for the claimed composition fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase with respect to the generic claimed composition in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is support for specific exemplified compositions Example 1 and Example 2 on the last page of the specification showing no settling after six months, there is no support for a composition encompassed within the scope of the instant claims not showing settling after six months.

(Office Action of 1/5/09, p. 2, Section 5.)

The PTO further contends:

In response [to Applicants arguments in the Amendment of 4/7/09], case law holds that, with respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Therefore, even though the specification discloses 1 year, such does not inherently support 6 months

(Office Action of 6/24/09, p. 3, Section 6)

Applicants greatly appreciate the detailed bases of rejection but must respectfully disagree in regards to the inventions of independent claims 1 and 18.

The first paragraph of 35 U.S.C. § 112 states: "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." 35 U.S.C. § 112, ¶ 1 (1994). "The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir.

1985) (*quoting In re Kaslow*, 707, F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

In order to determine whether an application meets the “written description” requirement with respect to later-filed claims, the application need not describe the claimed subject matter in exactly the same terms as used in the claims, *In re Lukach*, 442 F.2d 967, 969, 169 U.S.P.Q. 795 (C.C.P.A. 1971). It must simply indicate to those of ordinary skill in the art that as of the filing date the applicant had invented what is now claimed. *Id.*, at 1563, 19 U.S.P.Q.2d at 1116; see *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90, (C.C.P.A. 1976).

In particular, if a limitation is not explicitly described, it may still meet the description requirement if the concept of what is claimed is “inherent” in what is described. A chemical composition and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The specification specifically supports a composition “storable for more than one year without settling” (p. 4, para. 15). The PTO implicitly accepts this limitation in its allowance of claim 18. A composition storable for more than one year must necessarily be storable after six months as well. Therefore the limitation of storable after six months is not only literally supported by Examples 1 and 2, but it is also inherent in the disclosure of storable for more than a year.

Moreover, Applicants reject the PTO’s contention that “[w]hile there is support for specific exemplified compositions Example 1 and Example 2 on the last page of the specification showing no settling after six months, there is no support for a composition encompassed within the scope of the instant claims not showing settling after six months” (Office Action of 6/24/09, page 3, first paragraph). If the PTO were correct on this point, then claims would always be limited to infinitely narrow claims based on each working example. The PTO’s comments ignore the express teachings of the Specification with regard to storage stability for more than a year.

Applicants respectfully submit that their application as filed “reasonably conveys to the artisan that the inventor had possession” of the inventions of the present claims, i.e. a pigment paste storable for more than six months.

Accordingly, reconsideration and removal of the written description rejection of claims 1-11 and 15-17 is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/
Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

Monday, August 24, 2009

CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
Wyandotte, MI 48192
Customer No. 77224

MEG/DJJ